

#11/1/03
J. Douglas
9/20/03Mail Stop AF - After Final
Expedited Procedure

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Charles B. DIETERICH

: Art Unit: 2614

Appl. Serial No. 09/588,276

: Examiner: Trang U. Tran

Filed: June 6, 2000

: Confirmation No. 8138

For: BITSTREAM TESTING METHOD AND
APPARATUS EMPLOYING
EMBEDDED REFERENCE DATA:

OFFICIAL

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REQUEST FOR CORRECTED OFFICE ACTION
AND RESTARTING OF THE PERIOD FOR RESPONSE

This Request for Corrected Office Action and Restarting of the Period for Response is submitted in response to the Final Office Letter mailed August 13, 2003 in the above-captioned Application for which the three-month shortened statutory period for response expires November 13, 2003.

This Request is submitted within one month of the mailing date of the Office Action and so restarting of the period for response is appropriate and is requested. MPEP §710.06.

Background:

The present Office Action follows a response that was filed on March 24, 2003, with a Declaration of Michael Isnardi making certain facts of record.

Applicant elected to proceed with a Telephone Interview on March 3, 2003, when the

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Primary Examiner unexpectedly became unavailable at the last minute, in view of the understanding that either an opportunity for a telephone interview including the Primary Examiner or a non-final action would follow. (See Amendment filed March 24, 2003, at page 4). Nevertheless, the Examiner has made the present Office action Final.

Basis for Request for Corrected Action:

The present Office Action is defective in that it contradicts and ignores the uncontroverted evidence of record regarding U.S. Patent 6,400,400 to Michael Isnardi et al.

Specifically, Applicant submitted a Declaration of Michael Isnardi who is one of the named inventors of the Isnardi patent reference applied by the Examiner. The Isnardi Declaration makes of record facts regarding what the Isnardi Patent does describe and what it does not describe. The present Office Action does not even acknowledge Dr. Isnardi's Declaration and fails to address or consider the facts it states.

In the Response to Arguments section of the present Office Action, the Examiner disagrees with the facts set forth in Dr. Isnardi's Declaration without any basis in evidence for doing so. For example:

"In re pages 4-4..." - Regarding claim 1, the Examiner in the third paragraph on page 2 of the present Office Action misstates what Applicant has stated at page 4 of the Response and disregards the direct support therefor in paragraph 5 of Dr. Isnardi's Declaration which is referenced at the top of page 5 of the Response. Moreover, the Examiner's statement does not appear to correctly reflect what is recited in the claim or what is stated repeatedly in the response, i.e. that two differently-coded regions of a reference image are utilized in at least one picture. (See the last three paragraphs on page 5 of the Response.)

"In re page 8,..." - Regarding claim 7, the Examiner in the second paragraph on page 4 of the present Office Action asserts that the Isnardi Patent discloses the exact feature that Dr. Isnardi in paragraph 10 of his Declaration states it does not disclose. .

"In re page 8,..." - Regarding claim 13, the Examiner in the third paragraph on page 5 of the present Office Action asserts that the Isnardi Patent discloses the exact feature that Dr. Isnardi in paragraph 10 of his Declaration states it does not disclose. .

"In re pages 8-9,..." - Regarding claim 20, the Examiner in the first paragraph on page 7 of the present Office Action asserts that the Isnardi Patent discloses the exact feature that Dr. Isnardi in paragraph 10 of his Declaration states it does not disclose. .

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"In re page 9,..." – Regarding claim 26, the Examiner in the second full paragraph on page 8 of the present Office Action asserts that the Isnardi Patent discloses the exact feature that Dr. Isnardi in paragraph 10 of his Declaration states it does not disclose. .

Dr. Isnardi has an earned Doctorate degree in Electrical Engineering from M.I.T. and over 16 years of experience in the field of television and video processing. Dr. Isnardi has also authored many technical articles and is named in over thirty patents and patent applications in this field. It is submitted that Dr. Isnardi is highly qualified technically and that his Declaration should be accepted for what it states.

There is no evidence of record to counter the facts set forth on the record by Dr. Isnardi. Yet the Examiner simply contradicts and ignores the facts set for by Dr. Isnardi. This is improper under the Rules and so the rejection is defective and should be corrected and reissued.

Further, in the present final rejection of the claims, the Examiner's has merely repeated the anticipation rejection under section §102(e) as stated in the previous office action notwithstanding that the basis for that rejection is specifically refuted by the facts presented in Dr. Isnardi's Declaration. In particular, paragraph 10 of Dr. Isnardi's Declaration specifically refuted the basis for rejection again set forth by the Examiner at page 9 of the present Office Action regarding claim 1 which is also repeatedly applied at page 11 as to independent claims 7, 13, 20 and 26.

Formal Drawing:

Applicants submitted two sheets of formal drawing in a separate paper addressed to the Official Draftsperson filed with certificate of mailing dated March 24, 2003, approval of which is not reflected in the present Office Action.

The Office Action Summary incorrectly indicates (box 11) that a drawing correction was filed March 24, 2003 when such is not the case. Applicant believes that box 10 should be marked. Correction is requested.

Approval of the formal drawing and confirmation thereof in the corrected Office Action is solicited.

Conclusion:

Applicant respectfully requests that the Office Action mailed on March 24, 2003 be withdrawn, and that a corrected Office Action be issued. Applicant further requests that the period for responding to the corrected Office Action be restarted based upon the mailing date

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of the corrected Action.

Applicant further requests that the corrected Office Action be a Notice of Allowance based upon consideration of the evidence and argument presented in the previous response.

No fee is due in consequence of this Request. However, should any fee be due, please charge such fee and deposit any refund to Deposit Account 04-1406 of Dann, Dorfman, Herrell & Skillman.

The Examiner is requested to telephone the undersigned attorney if there is any question or if prosecution of this Application could be furthered by telephone.

Respectfully submitted,
Dann, Dorfman, Herrell & Skillman, P.C.
Attorneys for Applicant(s)

By: 
Clement A. Berard
PTO Registration No. 29,613

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September 8, 2003

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